Remarks/Arguments

The Office Action stated that this Office Action is in response to applicants' communication filed on 6/21/2006.

The Office Action stated that Claims 1 to 5 are pending in this application.

Claims 1 to 10 are pending. Claims 6 to 10 were added by the Preliminary Amendment of April 21, 2007. Claims 1 to 4 have been amended.

The Office Action stated: that receipt is acknowledged of the information disclosure statement (IDS) filed on 4/24/2006; that the submission is in compliance with the provisions of 37 CFR 1.97; and that, accordingly, the information disclosure statement is being considered by the Examiner.

The Office Action stated that the following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being confusing, because of the "or a E or Z isomer thereof" description.

The Office Action states that applicants have not clearly stated if the E or Z isomer is only for the enol isomer functionality; and that clarification is requested. Claim 4 has been amended to eliminate this matter. Claims 1 and 2 have not been amended regarding this matter. Z and E isomers can only be defined regarding the enols of formula Ib comprising a double bond, and not regarding the 3,5-dicarbonyl esters of formula I.

This rejection should be withdrawn.

The Office Action stated:

> A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ... "

(Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See Miller v. Eagle Mfg. Co., 151 U.S. 186 (1894); In re Ockert, 245 F.2d 467,114 USPQ 330 (CCPA 1957); and In re Vogel, 422 F.2d 438,164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 to 5 have been provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of Claims 1 to 5 of copending Application No. 11/416,212. Applicants traverse this rejection as to the amended and other claims.

The claims in this application and/or U.S.S.N. 11/416,212 so as to the claims in both applications are no longer coextensive in scope. Accordingly, this statutory double patenting no longer exists.

The Office Action stated that this is a provisional double patenting rejection since the conflicting claims have not in fact been patented. This statutory double patenting rejection no longer applies.

This rejection should be withdrawn.

Support for the Claim 6 is found on page 4, lines 16 to 19. Support for Claim 7 is found on page 4, lines 16 and 17, and on page 3, lines 21 to 23. Support for Claim 8 is found on page 4, lines 16 and 17, and on page 3, lines 21 to 27. Support for Claim 9 is found on page 4, lines 16 and 17, and on page 3, lines 21 to 27. Support for Claim 10 is found on page 4, lines 16 and 17, and on page 3, lines 21 to 27.

Claim 3 herein has been amended to eliminate its identical scope as Claim 3 in U.S.S.N. 11/416,212. Other claims in U.S.S.N. 11/416,212 have been amended or rewritten to eliminate or avoid identical scope problems.

Since the statutory double patenting problem has been removed, applicants have submitted concurrently herewith an executed terminal disclaimer (and terminal disclaimer fee) over U.S.S.N. 11/416,212 to eliminate any terminal disclaimer problem. A copy of the executed terminal disclaimer is enclosed.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

July 26, 2007
Date

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment Patent, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 26, 2007.

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